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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,966	02/28/2002	Gerald D. Eckstein	8266-0823	3797

7590 11/04/2002

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EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,966

Applicant(s)

ECKSTEIN ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Information Disclosure Statement

2. The information disclosure statement filed 6 June 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but German and French references referred to therein have not been considered.

Specification

3. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (see MPEP 608.01(o)). Specifically, the terms “a device” and “a support device” are not clearly defined in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-27 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble to claim 21 recites “[a] valve assembly for a hospitable bed” (i.e., the claims are drawn to a valve assembly with an intended use “for a hospital bed”). However, the body of claim appears to positively recite “a device for positioning the bed” in lines 2 and 3. The preamble to the claim does not appear to be commensurate in scope to the body of the claim because the “device” does not appear to be part of a “valve assembly”. Furthermore, what does “a device” mean? The only “device” mentioned in the specification is on page 1, line 9 (“patient support devices such as hospital beds”). However, if “a device” is meant to be a hospital bed, then it is a double inclusion of “a hospital bed” in the intended use recitation of the preamble.

Claim 40 has similar recitations to “a support device” and “a device” in lines 1-3. These are more problematic in that “a device” in line 2 appears to be a double inclusion of “a support device” in line 1.

In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21, 25-26, and 40 (as understood) rejected under 35 U.S.C. 102(b) as being anticipated by Brudnicki et al. (US Patent Number 5,529,281).

Brudnicki et al. disclose a valve assembly with a manifold (12) having an inlet, outlet, and a conduit (14), a valve (40) to inhibit or permit flow between the inlet and outlet, a lever (56) pivotally connected to the manifold and located entirely outside the conduit, and a solenoid (44, 30) positioned between the manifold and lever and directly connected to the valve for movement independent of the lever.

“[F]or a hospital bed”, “connected to a device for positioning the bed”, “for a support bed”, “connected to a device for positioning the support device” appear to be intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 27 (as understood) is rejected under 35 U.S.C. 103(a) as being unpatentable over Brudnicki et al.

Brudnicki et al. disclose a valve stem (58) with an opening for the lever rather than the lever having an opening for the valve stem. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have located the opening of Brudnicki et al. on the lever rather the valve stem and had the valve stem received in the opening because applicant has not disclosed that the location of the opening and which part is received into which other part provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary

skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the arrangement of Brudnicki et al. or the arrangement as set forth in claim 27 because the lever is attached to the valve stem, and also the valve itself, in either arrangement and the functions of both arrangements are the same. Therefore, it would have been an obvious matter of design choice to modify Brudnicki et al. to obtain the invention as specified in claim 27.

10. Claims 22-24 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Brudnicki et al. as applied to claim 21 above, and further in view of McNabb (US Patent Number 5,487,493).

Brudnicki et al. fail to disclose the lock engaging the lever as a lock bar and a lock solenoid. McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Brudnicki et al. in order to secure the lever in position as taught by McNabb. Note, McNabb discloses locking the lever in the closed position. It is considered within the ordinary skill of the art to lock the lever in the open position as well.

Conclusion

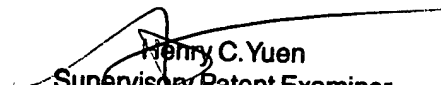
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry C. Yuen can be reached on (703) 308-1946. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3588 for regular communications and (703) 305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK 29 OCT 02
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October 29, 2002


Henry C. Yuen
Supervisory Patent Examiner
Group 3700